

REMARKS

The Claims

Claims 1-26 are in the case. Claims 1-15 and 17-21 have been amended. Claims 16 and 24 have been cancelled. Claim 26 has been added by amendment. Claims 22-23 remain unchanged.

Claim 1 has been amended to include the structural feature of claim 16.

In one aspect, recited in amended claim 1, Applicant's invention features a shoe including (a) an outsole having an upper surface, a lower surface and a heel section, the upper surface being positioned closer to a wearer's foot when the shoe is worn, the outsole further having an aperture in the heel section extending from the upper surface to the lower surface, and (b) a resilient, flexible first cushion disposed on the upper surface of the member in the heel section, the first cushion being shaped to protrude through the aperture. The lower surface includes a recessed portion, disposed around the aperture, the recessed portion having sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking.

In another aspect, recited in claim 22, Applicant's invention features a shoe outsole including (a) a member having an upper surface, a lower surface, a heel section, and a sidewall along the heel section, the member further having an aperture in the heel section extending from the upper surface to the lower surface and a cut-out portion in the sidewall, and (b) a resilient, flexible cushion disposed on the upper surface of the member in the heel section, the cushion being shaped to protrude through the aperture and to protrude through the cut-out portion.

Rejections Under 35 U.S.C. §102

Applicant's independent claims 1 and 24 have been rejected being anticipated by Gross, Dyer, Pavone, or Preston. Dependent claim 16, the structural limitation of which has been added to claim 1, has only been rejected as anticipated by Preston. Applicant will explain below why claim 1, as amended, is not anticipated by Preston. Claim 24 has been cancelled, obviating the rejection as it applied to this claim.

Applicant's independent claim 22 has been rejected as being anticipated by Pavone. Applicant will explain below why this rejection should be withdrawn.

Various dependent claims have also been rejected as anticipated by these references. The dependent claims are patentable for at least the reasons discussed below.

Claim 1

As amended, claim 1 requires that the lower surface include a recessed portion, disposed around the aperture (as recited in original claim 16), and also that the recessed portion have sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking.

As acknowledged by the Examiner, claim 16 is not anticipated by Gross, Dyer or Pavone.

Nor is amended claim 1 anticipated by Preston. Preston does not teach a recess on the lower surface of the outsole having sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking. Instead, in the Preston shoe, as body weight is applied to the outsole, the plug body 23 makes contact with the walking surface "to absorb the energy that would normally be applied only to the pad 26" (col. 2, lines 44-48).

Claim 22

Claim 22 requires that the cushion be shaped to protrude through a cut-out portion in the sidewall of the outsole. There is no indication that this is the case in the Pavone shoe. Pavone only mentions the openings 21, 22 in the sidewall of his sole once in his entire disclosure, saying only: "shown in FIG. 1 are openings in the sole 21, 22 where the helium modules *are visible*" (col. 1, lines 61-63, emphasis ours). There is nothing to indicate that the modules *protrude through* the openings 21, 22, as claimed.

Thus, Pavone does not anticipate claim 22.

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. §102 be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1 and 5-9 have been rejected as being unpatentable over Duclos in view of either Dyer or Preston. Claims 1 and 10 have been rejected as being unpatentable over Parisotto in view of either Dyer or Preston.

Duclos and Parisotto, cited for teachings of grid patterns, do not supply that which is lacking in the Preston and Pavone references, as discussed above. Accordingly, Applicant respectfully requests that these rejections be withdrawn.

Rejections Under 35 U.S.C. §112

Claim 21 has been rejected under 35 U.S.C. §112, second paragraph. Applicant has amended claim 21 to address this rejection.

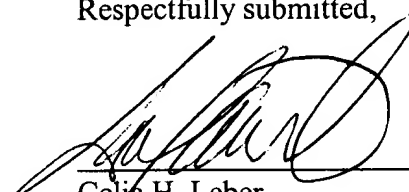
Conclusion

Attached is a marked-up version of the changes being made by the current amendment.

Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Version with markings to show changes made

In the claims:

Claims 16 and 24 have been cancelled.

Claims 1-15 and 17-21 have been amended as follows:

1. A shoe [outsole] comprising:

[a member] an outsole having an upper surface, a lower surface and a heel section, the upper surface being positioned closer to a wearer's foot when the shoe is worn, the [member] outsole further having an aperture in the heel section extending from the upper surface to the lower surface; and

a resilient, flexible first cushion disposed on the upper surface of the member in the heel section, the first cushion being shaped to protrude through the aperture;

the lower surface including a recessed portion, disposed around the aperture, the recessed portion having sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking.

2. The shoe [outsole] according to claim 1 wherein the [member] outsole comprises rubber.

3. The shoe [outsole] according to claim 1 wherein the [member] outsole comprises a thermoplastic resin.

4. The shoe [outsole] according to claim 1 wherein the [member] outsole is formed by molding.

5. The shoe [outsole] according to claim 1 wherein the lower surface of the [member] outsole has a groove formed therein to enhance the flexibility of the [member] outsole.

6. The shoe [outsole] according to claim 5 wherein the [member] outsole has a width, and the groove substantially traverses the width of the [member] outsole.

7. The shoe [outsole] according to claim 5 wherein the [member] outsole has a perimeter, and the groove has a closed-loop shape substantially parallel to the perimeter of the [member] outsole.

8. The shoe [outsole] according to claim 5 wherein the groove has a substantially semi-circular shape.

9. The shoe [outsole] according to claim 1 wherein the lower surface of the [member] outsole has a grid pattern formed therein to enhance the flexibility of the [member] outsole.

10. The shoe [outsole] according to claim 1 wherein the upper surface of the [member] outsole has a grid pattern formed therein to enhance the flexibility of the [member] outsole.

11. The shoe [outsole] according to claim 1 wherein the first cushion includes a protrusion that protrudes through the aperture.

12. The shoe [outsole] according to claim 1 wherein the first cushion comprises a polymeric gelatinous material.

13. The shoe [outsole] according to claim 1 wherein the first cushion further comprises a flexible, resilient sheet.

14. The shoe [outsole] according to claim 13 wherein the sheet comprises polyurethane.

15. The shoe [outsole] according to claim 1 wherein the upper surface of the [member] outsole includes a recessed area for receiving the first cushion.

17. The shoe [outsole] according to claim 1 wherein the [member] outsole includes a plurality of apertures.

18. The shoe [outsole] according to claim 1 wherein the [member] outsole further comprises a sidewall along the heel section of the member, the sidewall including a cut-out portion.

19. The shoe [outsole] according to claim 18 wherein the cut-out portion is a slit.

20. The shoe [outsole] according to claim 18 further comprising a second cushion disposed in the member adjacent to the cut-out portion.

21. The shoe [outsole] according to claim 20 wherein the second cushion is [capable of protruding] shaped to protrude through the cut-out portion during heel strike.